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Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
<b>CERTIFICATE OF FACSIMILE</b> I hereby certify that this Pre-Appeal Brief Request For Review and Notice of Appeal are being facsimile transmitted to (571) 273-8300. on <u>March 29, 2007</u> Signature _____ Typed or printed name <u>Theresa M. Palmateer</u>		Application Number	Filed
		09/921,803	08/03/2001
		First Named Inventor	
		O'Donnell, Hugh James	
		Art Unit	Examiner
		3654	Kruer, Stefan
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>37,139</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

  
Signature  
David J. Gaskey  
Typed or printed name  
(248) 988-8360  
Telephone number  
March 29, 2007  
Date

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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60,469-037  
OT-4812

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: O'Donnell, et al.  
Serial No.: 09/921,803  
Filed: 08/03/2001  
Group Art Unit: 3654  
Examiner: Kruer, Stefan  
For: ELEVATOR BELT ASSEMBLY WITH WAXLESS COATING

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

There is no *prima facie* case of anticipation or obviousness against any of Applicant's claims. The Examiner's position regarding the cited *Wilcox* reference (US Patent No. 4,624,097) is directly contrary to the express teachings of the reference. There is no reason for this case to go to the Board of Appeals when there is no basis for the rejections.

The Examiner asserts that the *Wilcox* reference teaches "coating the load carrying members with a single urethane coating (column 2, line 44) that does not contain wax (column 3, lines 1 and 60)." That assertion is directly contrary to what the *Wilcox* reference actually teaches because it expressly teaches that the jacket 32 of that reference includes wax.

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The *Wilcox* reference teaches that its jacket 32 is made of HYTREL, which is a polyester elastomer. There is nothing to indicate that the HYTREL material is made different than other polyester elastomers, which typically include some form of wax. Moreover, column 3, line 1, says that a "fatty acid amide was used as a lubricant during manufacture so that this lubricant was present in the finished rope." Applicant already provided sufficient evidence to demonstrate that a fatty acid amide is a wax. Therefore, the *Wilcox* reference expressly teaches that a wax (i.e., a fatty acid amide) is present in the finished rope. It is therefore impossible to interpret the *Wilcox* reference as having a jacket "that does not contain wax." Given that a wax is present in the *Wilcox* reference jacket, there is no possible *prima facie* case of anticipation against any of Applicant's claims, which include a "urethane that does not include wax" or a "waxless urethane."

Additionally, Column 3, line 60 through column 4, line 4, of the *Wilcox* reference teach additional lubricants that are described as "beneficial in the finished product" including waxes of various sorts. These portions of the *Wilcox* description also state explicitly that wax is included in the jacket 32.


Because the *Wilcox* reference clearly discloses a wax contained within the jacket 32, it does not teach what the Examiner contends. Therefore, there is no *prima facie* case of anticipation and the rejection under 35 U.S.C. §102 must be withdrawn.

The rejection under 35 U.S.C. §103 relies upon the same erroneous interpretation of the *Wilcox* reference. There is no *prima facie* case of obviousness because the reference does not teach what the Examiner contends. That rejection should be withdrawn, also.

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Respectfully submitted,

CARLSON, GASKEY & OLDS

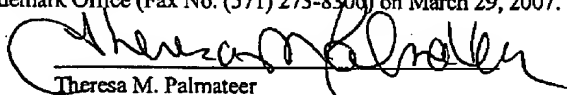


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Dated: March 29, 2007

**CERTIFICATE OF FACSIMILE**

I hereby certify that this Pre-Appeal Brief Request for Review relative to Application Serial No. 09/921,803 is being facsimile transmitted to the Patent and Trademark Office (Fax No. (571) 273-8300) on March 29, 2007.

  
Theresa M. Palmateer